

REMARKS

Claims 1-15, 22 and 25 are pending and under consideration. Claims 16-21, 23-24, and 26-27 are withdrawn, since they are drawn to non-elected restriction groups. Claims 1, 8, and 12 are amended herewith, claims 2, 3, 10, 13, and 14 are canceled herewith, without prejudice against their reintroduction into this or one or more timely filed continuation, divisional or continuation-in-part applications.

Thus, upon entry of this amendment, claims 1, 4-9, 11, 12, and 15 are pending and under consideration.

The amendments of the claims, specification, drawings, and the various rejections raised in the Office Action are discussed in more detail, below.

Reconsideration and withdrawal of the rejections set forth in the Office action dated October 16, 2007 are respectfully requested.

I. Amendments

Claim 1 is amended to recite "A gene comprising at least one promoter ... wherein the promoter has a sequence set forth in SEQ ID NO: 1."

Claim 8 is amended to recite "A promoter promoting a specific level of expression ... wherein the promoter has a sequence set forth in SEQ ID NO: 1."

Claim 12 is amended to recite "An expression cassette comprising a promoter of claim 8."

Basis for these amendments is found in the specification-as-filed on page 46, lines 22-24, and page 51, lines 8-10.

No new matter is added by way of these amendments.

II. Objections to the Specification

The specification was objected to because it contains an embedded hyperlink and/or other from of browser executable code. Applicants have amended the specification to remove the browser executable code. The specification was objected to since the specification refers to SEQ ID NO: 1 as CG0050_1, while Fig. 4 and Fig. 5 recite 50060. Applicants have amended the specification in accord with the Office's suggestion.

The specification has been amended such that the description of Fig. 3, Fig. 4, and Fig. 5 recites "50060 shows a clone CG0060_1." The description of Fig. 3 has been further amended to note that clone CG0060_1 is SEQ ID NO:1. Support for these amendments is found at least on page 46, lines 22-24; page 48, lines 24-28; page 51, lines 7-10, and in Table 1 of the specification as filed. In light of these amendments, Applicants request withdrawal of the objection.

III. Rejection under 35 U.S.C. §112, first paragraph

Claims 1-15 were rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. The claims allegedly contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention.

Claims 1-15 were further rejected under 35 U.S.C. §112, first paragraph, allegedly because the specification does not enable any person skilled in the art to which it pertains, or with which it is most connected to make and use the invention commensurate in scope with the claims.

This rejection is respectfully traversed in view of the following.

A. Written Description

The Office asserts that the specification fails to provide an adequate written description of the invention as claimed. Applicants disagree.

Nonetheless, without acquiescence to the rejection, but solely to advance prosecution, Applicants have amended the claims to recite, "wherein the promoter has a sequence set forth in SEQ ID NO: 1," obviating the rejection.

One skilled in the art would reasonably conclude that Applicants were in possession of the claimed subject matter at the time the application was filed. Withdrawal of the rejection of the claims under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described at the time of the filing is respectfully requested.

B. Enablement

At page 7 of the Office Action, it is clearly acknowledged that the specification is enabling for SEQ ID NO:1. Without acquiescence to the reasoning of the Office Action,

but merely to expedite prosecution, Applicants have amended the claims to recite "wherein the promoter has a sequence set forth in SEQ ID NO: 1", thereby obviating the rejection.

In light of the above, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112, first paragraph.

IV. Rejection under 35 U.S.C. §112, second paragraph

Claims 1-15, 22 and 25 were rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention.

As the amendments to claims 1, 8, and 12 remove the allegedly offending phrases, the rejection is moot. Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. §112, second paragraph.

V. Rejection under 35 U.S.C. § 102

Claims 1-4, 6-15 were rejected under 35 U.S.C. § 102(b) as allegedly anticipated by Conner, *et al.* (WO/01/16307) (hereinafter "Conner, *et al.*"). This rejection is respectfully traversed.

A. The Present Claims

As amended, the claims are directed to a plant comprising at least one promoter promoting a specific level of expression and a gene operably linked to the promoter, wherein the promoter has a sequence set forth in SEQ ID NO: 1.

The Office Action states on page 14 that "SEQ ID NO: 1 is deemed free of the prior art." Furthermore claims 22 and 25 are deemed free of the prior art given the failure of the prior art to teach or reasonably suggest a promoter having the sequence of SEQ ID NO: 1. Because Applicants have amended the claims to recite a promoter having the sequence set forth in SEQ ID NO: 1, Conner, *et al.* fail to anticipate the subject matter as presently claimed.

Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 102.

VI. Rejection under 35 U.S.C. §103

Claims 1-15 were rejected under 35 U.S.C. §103 as allegedly obvious over Conner, *et al.*, or Conner, *et al.* in view of Draper (U.S. Patent 6,031,151). This rejection is respectfully traversed.

A. The Present Claims

As amended, the claims relate to a plant comprising at least one promoter promoting a specific level of expression and a gene operably linked to the promoter, wherein the promoter has a sequence set forth in SEQ ID NO: 1.

B. The Cited Art

DRAPER describes a callus-specific promoter which does not have the sequence of SEQ ID NO: 1.

C. Analysis

According to the M.P.E.P. § 2143, to establish a *prima facie* case of obviousness, three basic criteria must be met. The third criterion is that the prior art references (or references when combined) must teach or suggest all the claim limitations.

The Office has failed to establish that the cited references teach or suggest all the claim limitations and make the claims *prima facie* obvious. As amended, the claims are directed to a plant comprising at least one promoter promoting a specific level of expression and a gene operably linked to the promoter, wherein the promoter has a sequence set forth in SEQ ID NO: 1. Neither Conner *et al.*, nor Conner *et al.* in view of Draper disclose a promoter of SEQ ID NO: 1. Furthermore, the Office has acknowledged that this promoter is free of the prior art.

Because the references alone or in combination fail to teach or suggest all the elements, the rejection under 35 U.S.C § 103 is not applicable to the claims as amended. Withdrawal of this rejection is respectfully requested.

CONCLUSION

In view of the foregoing, the pending claims of the application are believed to satisfy all of the criteria for patentability and are in condition for Allowance. A Notice of Allowance is therefore respectfully requested.

No fees are believed to be due in connection with this Amendment. However, the Commissioner is authorized to charge any additional fees that may be required, or credit any overpayment, to Perkins Coie LLP Deposit Account No. 50-2207.

If in the opinion of the Examiner a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4428.

Respectfully submitted,
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